

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on May 21, 2009, claims 1-24 are pending and stand rejected. Claims 1-24 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement; Claims 1-16 and 18-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. (5,295,064) in view of Vogelmann et al. (5,264,822) in further view of Ruppert et al. (5,640,002). Accordingly, Applicant respectfully provides the following:

### **Rejections under 35 U.S.C. § 112:**

Claims 1-24 stand rejected under 35 U.S.C. Section 112, first paragraph as failing to comply with the enablement requirement. The claims recite allowing reception of promotion without the use of trigger signals associated with fixed positions in the store. The pending Action indicates that page 9 of the specification indicates the use of signals to activate the display of the advertisement. However, the embodiment disclosed on page 9 is not the only embodiment contemplated by the presently allowed application. Under other embodiments disclosed in the specification, communication between the central server and the cart may be accomplished without utilizing triggers located at discrete locations throughout the store. Under these embodiments the shopping cart could be at any position in the store and receive a signal from the central server, wherein the information comprises a non-repetitive visual message containing a product's specific promotions, allowing a user to interactively request information utilizing the computer display from a communication center resident at the store through a transceiver unit for display on the display screen in real time without contextual meaningful delay. For example, page 3 of the specification provides "in one particular embodiment, an

advertising and promotions system is provided, in accordance with the principles of the present disclosure. The advertising and promotion system may include a display unit on a shopping cart, a plurality of store-wide trigger or transuper units, a host computer and a battery charger connected to the display unit and mounted on a desired location on the shopping cart.” (emphasis added) Lines 14-18. The specification provides for a system that may utilize store-wide triggers or transceiver units. Accordingly, in some embodiments of the presently claimed invention a shopping cart may receive information from transceiver units regardless of the position of the shopping cart in the shopping environment. Because the claimed embodiment finds direct support in the specification as originally filed, Applicant respectfully requests that the Section 112, enablement rejection be withdrawn at this time.

**Rejections under 35 U.S.C. § 103(a):**

Claims 1-16 and 18-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,295,064 (“Malec”) in view of U.S. Patent No. 5,264,822 (“Vogelman”) in further view of U.S. Patent No. 5,640,002 (“Ruppert”) and claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Malec in view of Vogelmann in further view of Ruppert in further view of MacIntyer.

Applicant respectfully submits that the references cited in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicants also respectfully submit that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

One of ordinary skill in the art, utilizing Malec as a primary source of information, would not have been motivated to alter Malec's advanced system for providing dynamic and changing advertisements to shopping cart display systems with information from Vogelmann, which teaches a simple system for providing audio advertising messages to shopping carts moving through spatially defined transmissions zones arranged in the store. The Court in *KSR* expressly instructs that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) at 1396. This concept has been reinforced in recent jurisprudence. In particular, the Federal Circuit in *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, nos. 2008-1240, -1253, 1401 affirmed a judgement of non-obviousness of claim to spinal surgery screw, observing that the "predictable result" test of *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) refers not just to whether prior art elements are capable of being physically combined, but also that the combination would have worked for its intended purpose, so that an interference of non-obviousness "is especially strong where the prior art's teachings undermine the very reason being proffered as to why" the skilled artisan would have combined the known elements. In *Depuy Spine*, the primary reference taught much of the claim except for a rigid screw for which a secondary reference was offered. However, the primary reference had expressed concern for failure stating that its "shock absorber" screw feature decreased the chance of failure inside the body, a casual relationship that would have been violated if the rigid element of the secondary reference were to replace the corresponding element of the primary reference.

Malec's disclosure contravenes the presumption that it would have been obvious to modify Malec's teachings by referencing Vogelmann. Predictability as discussed in *KSR* encompasses the expectation that prior art elements are capable of being combined, as well as the

expectation that the combination would have worked for its intended purpose. An inference that a claimed combination would not have been obvious is especially strong where the prior art's teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009). Malec expressly indicated that prior art systems utilized for in-store displays, while effective at influencing customers, had the general downfall of being physically fixed to a point of purchase within the store and utilized primarily to promote a single product or group of products and needed to be changed from time to time by store personnel. *Malec*, Column 1, lines 31-38. Malec's objective was to produce a sophisticated onboard shopping cart display system, "including a cart mounted display responsive to unique trigger signals provided by respective transmitters associated with respective fixed locations." In particular, Malec disclosed the use of an on-board computing system to facilitate display of a plethora of visual messages, print coupons and scents to be dispersed at appropriate locations upon receipt of the appropriate signal from a trigger transmitter. Malec directly indicates that his invention overcame the disadvantages of simply the prior art systems by providing customers with dynamically changing advertisements and information to influence the consumer. *Malec*, Column 1, lines 53-57. Malec's solution to the deficiencies of the prior art advertising systems was to provide a shopping cart with an onboard unit capable of providing flexible information stored at the cart.

Further, Vogelmann teaches away from the combination of Malec and Vogelmann, indicating that video-based systems utilize unnecessarily "complex equipment intensive and prone to failure, requiring high levels of maintenance. Furthermore, these systems require the shopper to continually look at the cart display while walking through the store aisles."

*Vogelman*, Column 1, lines 63-68. Accordingly, one skilled in the art would not be motivated to combine Vogelmann's teachings related to a simple audio transmission in view of Vogelmann's open teaching away from complex video systems with Malec's complex onboard video-based shopping cart apparatus. Vogelmann's system by contrast is simple system for broadcasting audio messages to shopping carts moving through a plurality of pre-defined spatial zones in a store, and incapable of transmitting complex, timely product specific information to individual shopping carts as they traverse a shopping environment.

Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Malec and Vogelmann in the manner suggested by the Office Action. Only by using the roadmap of the present invention would an artisan of ordinary skill combine these two references in such a manner. Applicants respectfully submit that the Examiner used the present invention as a roadmap to inappropriately combine the above-mentioned references. Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Malec and Vogelmann in the claimed manner.

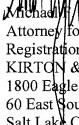
For at least these reasons, Applicant respectfully submits that claim 1 is not made obvious by the cited combination of references and therefore respectfully request removal of the rejection. Claims 2-23 depend from claim 1 and are allowable for at least the same reasons. Applicants therefore respectfully request removal of all remaining rejections.

### CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 27 day of September, 2010.

Respectfully submitted,



Michael V. Krieger  
Attorney for Applicants  
Registration No.: 35,232  
KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893

JRM:law